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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,908	11/27/2001	Subir K. Dey	3691-321	7677

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EXAMINER

CHEN, VIVIAN

ART UNIT PAPER NUMBER

1773

DATE MAILED: 02/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/993,908

Applicant(s)

DEY ET AL.

Examiner

Vivian Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2003 and 06 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 26-34 is/are pending in the application.
- 4a) Of the above claim(s) 3 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 26-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3/03 11/01 6) ☐ Other:

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DETAILED ACTION

1. Claims 12-25 have been cancelled by Applicant.

Election/Restrictions

2. Applicant's election without traverse of Group I (claims 1-11, 26-34 in the Response filed 9/20/2003 is acknowledged.
3. Applicant's election of species A in the Supplemental Response filed 11/6/2003 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
4. Claims 2 and 31 (as related to species B) are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the Supplemental Response filed 11/6/2003.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 9-11, 25-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-34 of copending Application No. 09/993,909 (DEY ET AL).

Copending Application No. 09/993,909 claims the recited laminate containing a styrene block copolymer, layers, color and transparency characteristics, and articles made from said laminates.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 9-11, 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/30849 (hereinafter WO '849);

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in view of SMITH ET AL (US 6,187,233);

and in view of GERLOWSKI ET AL (US 4,996,086) or MACHADO ET AL (US 5,369,180).

WO '849 discloses a multilayer laminate comprising a polyketone layer, a tie layer, and a thermoplastic polyolefin layer, wherein the tie layer comprises a SEBS block copolymer (recited in claims 1, 28). However, the reference does not explicitly disclose a laminate with a clear coat layer or automotive trim components.

SMITH ET AL discloses that it is well known in the art to use thermoformable laminates comprising a colored base substrate and a upper clear layer having a transparency of preferably at least 90% to produce durable automotive trim articles (abstract, line 37, col. 8 to line 10, col. 9).

GERLOWSKI ET AL or MACHADO ET AL each disclose that polyketones are capable of forming transparent or clear layers and films. (GERLOWSKI ET AL, lines 3-10, col. 6) (MACHADO ET AL, lines 65-68, col. 6)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize a transparent polyketone polymer as a protective clear coat surface layer in the laminate of WO '849 in order to form laminates suitable for forming durable and colorful automotive trim components.

9. Claims 1, 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over HWANG ET AL (US 5,883,188) in view of SPAIN ET AL (US 5,284,693).

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HWANG ET AL discloses multilayer laminate comprising a paintable layer and a thermoplastic polyolefin layer, wherein the paintable layer comprises a SEBS block copolymer (columns 6-7). However, the reference does not explicitly disclose a laminate with a clear coat layer or automotive trim components.

SPAIN ET AL discloses that it is well known in the art to use polyvinyl fluoride as a clear coat layer over a colored underlayer of a thermoformable laminate in order to improve durability and weatherability (lines 20-32, col. 11).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply a known polyvinyl fluoride top coating to the paintable layer of HWANG ET AL in order to provide a protective clear coated thermoformable article.

10. Claims 1-2, 4-11, 26, 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over: QUINN ET AL (US 6,582,829) or KOMATSUZAKI ET AL (US 6,291,583).

The above references each disclose adhesive compositions suitable for adhering polymeric layers together, wherein the adhesive compositions comprise a branched styrene block copolymer and a tackifier resin such as terpene resins in amounts comparable to or equal to the amount of block copolymer present. (QUINN ET AL, lines 27-43, col. 6; line 40, col. 7 to line 17, col. 8) (KOMATSUZAKI ET AL, lines 23-32, col. 3; lines 11-44, col. 9; lines 23-40, col. 10)

It would have been obvious to use the disclose adhesive compositions to adhere a colored base layer with a transparent cover layers together in order to form multilayer labels, signs, packaging materials, and other conventional film and sheet articles with protected coloration,

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decorative effects and/or informational indicia. One of ordinary skill in the art would have adjusted the proportion of tackifier in the adhesive depending on the adhesive and tack properties desired for a given application. It is well known in the art to use fluorinated polymers such as polyvinyl fluoride as protective surface films (claims 10-11) for laminates because of their durability and weathering resistance and also to use thermoplastic olefins as base layers (claim 9) because of their processibility and low cost.

11. Claims 1, 9, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over: SAITOH ET AL (US 4,332,858).

SAITOH ET AL discloses multilayer laminates comprising a thermoplastic polyolefin base layer, an adherent intermediate layer, and a surface layer such as polycarbonate, wherein the intermediate layer comprises a styrene block copolymer. (columns 6-7) However, the reference does not explicitly disclose a laminate with a clear coat layer.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use clear polycarbonate resins as the surface layer in the laminate of SAITOH because of their durability and weathering resistance and also to color the base layer in order to form multilayer labels, signs, packaging materials, and other conventional film and sheet articles with protected coloration, decorative effects and/or informational indicia.

12. Claims 1-2, 4-9, 26-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over BEUZELIN ET AL (US 6,657,006), in view of SMITH ET AL (US 6,187,233).

BEUZELIN ET AL discloses a multilayer laminate comprising a polycarbonate or polyester layer, a tie layer, and a polyolefin layer, wherein the tie layer comprises a branched styrene block copolymer and a tackifying resin such as terpene (lines 27-40, col. 4; line 60, col. 4 to line 11, col. 5; lines 57-68, col. 5). However, the reference does not explicitly disclose a laminate with a clear surface layer or automotive trim components.

SMITH ET AL discloses that it is well known in the art to use thermoformable laminates comprising a colored base substrate and a upper clear layer having a transparency of preferably at least 90% to produce durable automotive trim articles (abstract, line 37, col. 8 to line 10, col. 9).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize transparent polycarbonate or polyester resins as a protective surface layer in the laminate of BEUZELIN ET AL in order to produce materials suitable for forming durable and colorful automotive trim components. One of ordinary skill in the art would have adjusted the proportion of tackifier in the adhesive depending on the adhesive and tack properties desired for a given application. Polycarbonates and polyesters are well known in the art for having excellent transparency and mechanical properties, and are commonly used in optical and/or protective applications.

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Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (571) 272-1516. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 6, 2004



Vivian Chen
Primary Examiner
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